

REMARKS

Claims 1, 3, 7, and 16 have been amended. Claims 2 and 20 have been canceled without prejudice or disclaimer as to the subject matter recited therein. Claims 1, 3-19, and 21-22 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Claim Objection

An objection was lodged against claim 16 for an informality. In response thereto, claim 16 has been amended to correct a dependency issue. Accordingly, Applicants believe this objection has been obviated.

Section 103 Rejection

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,321,098 to Beith et al. (hereinafter "Beith") in view of U.S. Patent No. 6,584,490 to Schuster et al. (hereinafter "Schuster"). In addition, claims 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,031,895 to Cohn et al. (hereinafter "Cohn") in view of Beith. For reasons set forth below, the rejection of claims 1-22 are respectfully traversed.

To establish a case of *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP 2143.03. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992); MPEP 2143.01. The cited art does not teach or suggest each and every limitation of the currently pending independent claims 1, 21, and 22, some distinctive limitation of which are set forth in more detail below. In addition to the patentable distinctions of the independent claims, Applicants also assert patentable distinctions of the dependent claims. The details of those distinctions will be described to any subsequent Office Actions. However, at present, the patentable distinctions of the independent claims are more than sufficient in light of the current cited art.

The combination of Beith, Schuster, and Cohn do not teach or suggest electronic notification associated with an identifier, a category heading, and an altered value (claim 1), or performing search and match steps using an identifier, category headings, and an altered value (claims 21 and 22). Each of the current independent claims describe a particular type of electronic notification. The electronic notification carries specific information. That information includes an identifier, a category heading, and an altered value. Upon receiving the electronic notification, the various pieces of information which comprise that electronic notification are compared against certain directory entries in order to determine whether the directory must be updated. Thus, the identifier, category heading, and the altered value of the electronic notification are compared with the directory entry to determine whether the directory entries are to be updated.

The present specification describes identifiers, category headings, and entry content values attributed to a directory of entries (Specification -- Fig. 2; pg. 16, line 13 - pg. 17, line 2). For example, the category heading might encompass multiple directory entries that have a common entity or theme (Specification -- pg. 6, lines 15-29). In order to determine whether the directory is to be updated, it is equally important to determine how to categorize the newly entered entry. Thus, not only are entries added, but they must be added according to specific identifiers (i.e., a set identifier, a subset identifier, or entry identifier), possibly according to a category or an altered value within the entry content values of the incoming electronic notification fields.

Applicants agree with the statement made on page 3 of the Office Action: "Beith fails to clearly teach an electronic notification." Absent any teachings of electronic notification, the Office Action attempts to fill the void with the teachings of Schuster (Office Action -- pg. 3). The only alleged reference to electronic notification in Schuster is the information sent across link 109 from PID 110 (Schuster -- Fig. 1). However, when referencing the information sent, the Office Action contends PID 110 forwards electronic notification in the form of an identifier, category heading, and an altered value (Office Action -- pg. 3 in reference to claim 2). Applicants disagree.

Nowhere in Schuster is there any teaching of PID 110 sending anything other than a user identifier (Schuster -- col. 7, lines 5-30). The user identifier is sent from PID 110 in order to allow the communication device 108 to take calls or initiate calls (Schuster -- col. 8, lines 34-39 and 42-48). Nowhere is there any reference to the user identifier being somehow a category or a heading within bits or "fields" of information and, certainly, there is no mention in Schuster that if a value is altered, the

electronic notification will notify a directory to update itself. In fact, the user identifier in Schuster has no control whatsoever of a directory, much less the control for updating a directory entry or entries.

Cohn has the same deficiencies as Beith and Schuster. Nowhere in Cohn is there any suggestion of electronic notification containing or associated with certain pieces of information as claimed. Moreover, the combination of Beith, Schuster, and Cohn cannot hypothetically teach the claimed pieces of information or the effect of that information when categorizing updates to directory entries based on altered values, etc.

For at least the reasons set forth above, none of the cited art, either separately or in combination, provides motivation to teach or suggest all limitations of independent claims 1, 21, and 22. Therefore, Applicants believe that independent claims 1, 21, and 22, as well as claims dependent therefrom, are patentable over the cited art. Accordingly, Applicants respectfully request removal of this rejection.

CONCLUSION

The present amendment and response is believed to be a complete response to all issues raised in the Office Action mailed October 22, 2003. In view of the remarks traversing the rejections presented therein, Applicants assert that pending claims 1, 3-19, and 21-22 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-05000.

Respectfully submitted,


Kevin L. Daffer
Reg. No. 34,146
Attorney for Applicant(s)

Conley Rose, P.C.
P.O. Box 684908
Austin, TX 78768-4908
(512) 476-1400
Date: January 22, 2004